

REMARKS

This is intended as a full and complete response to the Office Action dated September 19, 2006, having a shortened statutory period for response set to expire on December 19, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-20 are pending in the application. Claims 1-20 remain pending following entry of this response. Claims 1 and 5 have been amended. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 U.S.C. § 102

Claims 1-8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by *Nakamura et al.*, U.S. Patent Number 5,781,448 (hereinafter, "*Nakamura*").

Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Nakamura* does not disclose "each and every element as set forth in the claim." For example, with respect to claim 1, *Nakamura* does not disclose an "uninterruptible power supply (UPS) device for supplying power to the system resource in the event of input power failure, the UPS device further for supplying the service processor with information regarding the capability of the UPS device to power the system resource." The Examiner states that this element is taught by *Nakamura* at lines 60-67 of column 5 and lines 1-10 of columns 6. Applicants respectfully disagree.

The UPS 1 of *Nakamura* is not capable of providing a service processor with information regarding the capacity of the UPS device to power a system resource. Rather, the UPS 1 of *Nakamura* includes various measuring units (measuring units 14, 15, 16 and 17) that provide respective measurements to a controller 2. See, col. 6, lines 1-9 and lines 23-32. The controller must then process the received measurement values in order to predict a lifetime of the battery 12 of the UPS 1. Col. 6, lines 6-9. In other words, in *Nakamura* the measurement values received from the respective measuring units are merely raw data which must be processed by the controller 2 in order to obtain information regarding the capability of the UPS to power a system resource. Therefore, *Nakamura* does not teach an “uninterruptible power supply (UPS) device for supplying power to the system resource in the event of input power failure, the UPS device further for supplying the service processor with information regarding the capability of the UPS device to power the system resource.” Accordingly, Applicants respectfully request that the rejection be withdrawn and that the claim and its dependents be allowed.

Further, claim 1 has been amended to recite that the UPS device includes a processor configured to provide a service processor with the information regarding the capability of the UPS device to power the system resource. In *Nakamura*, the UPS device does not include a processor. Thus, Figure 3 shows a microprocessor 20 included with the controller 2, but no processors are shown with the UPS 1. Rather, the UPS 1 merely includes a plurality of measuring units (measuring units 14, 15, 16 and 17) that provide measurement values to the controller 2 for processing by the microprocessor 20. Accordingly, Applicants respectfully request that the rejection be withdrawn and that the claim and its dependents be allowed.

Claim 5 recites a UPS device having a processor for controlling a communication port to output, to a service processor, the information regarding the output capability of the UPS device. The Examiner again relies on lines 60-67 of column 5 and lines 1-10 of column 6 of *Nakamura*. Accordingly, Applicants believe this rejection is traversed on the basis of the arguments above regarding claim 1. Further, claim 5 has been

amended to recite that the processor of the UPS provides the output capacity information to a service processor, wherein the service processor is configured to issue control signals to the external system being powered by the UPS device. Accordingly, Applicants respectfully request that the rejection be withdrawn and that the claim and its dependents be allowed.

Claim 8 recites "an uninterruptible power supply (UPS) for supplying output AC power and for supplying UPS information comprising...UPS output capability information. Accordingly, claim 8 is believed to be allowable for the same reasons given above with respect to claim 1 in claim 5, since each of the claims include a limitation directed to the UPS device supplying information regarding the UPS device's output capability. Further, claim 8 recites that the UPS supplies "a UPS identifier." The Examiner suggests that this limitation is disclosed by the reference at lines 42-46 of column 6 and at lines 13-14 of column 7. Respectfully, after careful review of these portions of *Nakamura* Applicants determined that there is no disclosure of a UPS identifier, nor of a UPS device that supplies a UPS identifier. In fact, the Examiner's commentary regarding these portions of *Nakamura* refers to the teaching of "a system with a controller for controlling a UPS, the system having a memory for storing battery efficiencies." Office Action, p. 4. However, the claim element at issue is a UPS identifier provided by a UPS device, not the controller. Accordingly, Applicants respectfully request that the rejection be withdrawn and that the claim and its dependents be allowed.

Further, regarding claim 8, the Examiner argues that *Nakamura* at col. 4, lines 42-46 and col. 7, lines 13-14 teaches "a system resource for receiving emergency power from the UPS and UPS information and for sending the UPS information to the service processor" and also teaches a service processor that "receives and examines the UPS information supplied by the system resource". As an initial matter, Applicants respectfully point out that the Examiner appears to focus on the wrong element of *Nakamura*. The portions of *Nakamura* cited by the Examiner, and the Examiner's commentary, are directed to the controller 2. However, the device that receives power

from the UPS 2 of *Nakamura* is not the controller 2, but the "electronic system" 3 (Figure 3), and the electronic system 3 neither receives UPS information from the UPS 1, nor sends UPS information to the controller 2 (assuming, *arguendo*, that the controller 2 of *Nakamura* can be considered the claimed service processor). Accordingly, no system resource, as claimed, is disclosed by *Nakamura*. Accordingly, Applicants respectfully request that the rejection be withdrawn and that the claim and its dependents be allowed.

Claim Rejections - 35 U.S.C. § 103

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Nakamura* as applied to claim 8 above, and further in view of *Mullins et al.*, U.S. Patent Number 6,832,324 (hereinafter, "*Mullins*").

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criterion. Specifically, *Nakamura* does not teach each of the elements of claim 8 for the reasons discussed above. Therefore, claim 10 is believed to be allowable, and allowance of the claim is respectfully requested.

Allowable Subject Matter

Claims 14-20 are allowed.

Claims 9 and 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims. Applicants acknowledge the allowable claims. However, for the reasons given above Applicants believe that the base claims from which claims 9 and 11-12 depend are allowable. As a result, claims 9 and 11-12 are also believed to be allowable. Accordingly, Applicants respectfully request that the objection be withdrawn and the claims be allowed.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants